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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/699,464 | 10/31/2003 | Philip Carbone | SGS-101-DIV2 | 2781 |
| 42419 | 7590 | 11/01/2004 | EXAMINER | |
| PAULEY PETERSEN & ERICKSON 2800 WEST HIGGINS ROAD SUITE 365 HOFFMAN ESTATES, IL 60195 | | | LU, JIPING | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3749 | |

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,464

Applicant(s)

CARBONE ET AL.

Examiner

Jiping Lu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/9/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27 is/are allowed.
- 6) ☒ Claim(s) 23-26 and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
3. Claims 23-26, 28, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boros et al. (U. S. Pat. 5,941,200) in view of Taylor et al. (U. S. Pat. 4,397,299).

Boros et al. show a mounting apparatus for releasable attaching a burner assembly 52, 68 to a bottom wall 48 that at least partially defines a combustion chamber 18 of a water heater 10 comprising a flange 52 on the burner assembly and a removable screw 64 for fastening a second end of the flange against the bottom wall 48 same as claimed. However, Boros et al. do not show a clip with a base portion attached to the bottom wall and an end portion offset from the base portion forming a receiver for retaining a first portion of the flange. Taylor et al. teach a

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mounting apparatus for releasable attaching a burner assembly 70, 80 to the bottom wall 74, 76 comprising a clip 72, 78 with a base portion attached to the bottom wall and an end portion offset from the base forming a receiver for engaging the flange portion 120 of the burner 70,80 same as claimed. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the mounting apparatus of Boros et al. with a clip 72,78 of Taylor et al. in order to facilitate the installation of burner assembly to the water heater combustion chamber bottom wall. With regard to claim 26, examiner takes official notice that it is well known in the art to use latch as removable fastener.

4. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boros et al. (U. S. Pat. 5,941,200) in view of Taylor et al. (U. S. Pat. 4,397,299) as applied to claim 23 above, and further in view of Brandt et al. (U. S. RE 37,745)

The mounting apparatus of Boros et al. as modified by Taylor et al. as above includes all that is recited in claim 29 except for the number of burner assemblies. Brandt et al. teaches two burner assemblies 120 mounted on the water heater combustion chamber bottom wall same as claimed. Therefore, it would have been obvious one having ordinary skill in the art at the time the invention was made to provide the combustion chamber of Boros et al. with two burner assemblies as taught by Brande et al. in order to improve the heating efficiency.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 23 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 34 of copending Application No. 10/698,836. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a mounting apparatus for releasably attaching a burner assembly to a bottom wall of the combustion chamber of a water heater with a clip having an end portion spaced from the bottom wall forming a receiver, a first portion of the flange engageable within the receiver and a removable fastener fastening a second end of the flange against the bottom wall.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

6. Claim 27 is allowed.

Response to Arguments

7. Applicant's arguments filed 8/9/2004 have been fully considered but they are not persuasive. Boros et al. show a mounting apparatus for releasable attaching a burner assembly

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52, 68 to a bottom wall 48 with removable screw 64 for fastening a second end of the flange 52 against the bottom wall 48 same as claimed. Taylor et al. teach a mounting apparatus for releasable attaching a burner assembly 70, 80 to the bottom wall 74, 76 comprising a clip 72, 78 with a base portion attached to the bottom wall and an end portion offset from the base forming a receiver for engaging the flange portion 120 of the burner 70,80 same as claimed. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the mounting apparatus of Boros et al. with a clip 72,78 of Taylor et al. in order to facilitate the installation of burner assembly to the water heater combustion chamber bottom wall. The curved edge portion of circular mounting plate structure 52 of the Boros et al. Patent would be able to engage within a portion of the receiver of the clamp members 72,80 of the Taylor et al. Patent.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jiping Lu whose telephone number is 703-308-2354. The examiner can normally be reached on Monday-Friday, 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ira Lazarus can be reached on 703 308-1935. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jiping Lu
Primary Examiner
Art Unit 3749

J. L.